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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,141	10/14/2004	Tapio Viitamaki	121508	1976
25944	7590	02/08/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			TRIEU, THERESA	
			ART UNIT	PAPER NUMBER
			3748	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/511,141	<b>Applicant(s)</b> VIITAMAKI, TAPIO	
	<b>Examiner</b> Theresa Trieu	<b>Art Unit</b> 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct. 14, 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Apr. 20, 2005</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt and entry of Applicant's Preliminary Amendment filed on October 14, 2004 is acknowledged.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "spring 43 (see page 6, [0020] paragraph, line 5 and Fig. 8)"; head 46 (see page 6, [0021] paragraph, line 4 and Fig. 10)". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "42" has been used to designate both "edge (see Fig. 8)" and "spring (see Fig. 7)"; reference character "41" has been used to designate both "pin (see Fig. 7)" and "spring (see page 6, [0020] paragraph, line 5)"; reference character "44" has been used to designate both

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“second spring (see Fig. 8)” and “oil channel arrangement (see Fig. 9)”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 5 of Viitamaki (U.S. Patent No. 6,883,488) in view of Swinkels (Patent Number 4,005,951).

Regarding claims 1-3, Viitamaki '488 discloses a rotary combustion engine having a non-rotating annular outer/ inner casing (1, 3); a moving eccentric means (11, 12 and 8) comprising first and second eccentric rings (11, 12); a power shaft (5); a combustion chamber (14, 15); divider means (16) and a balancing arc (18). However, Viitamaki fails to disclose the vane type motor using operate as a hydraulic motor.

Swinkels teaches that it is conventional in the compressor art to utilize a hydraulic motor (see col. 1, line 5-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the hydraulic motor as taught by Swinkels in the Viitamaki '488 device, since the use thereof is shown to be conventionally utilized to pump/compress a liquid/air in the analogous device of the Viitamaki '488 device.

***Claim Rejections - 35 USC § 112***

4. Regarding claims 1 and 2, the word "means" is preceded by the word(s) "of hydraulic fluid; of this eccentric movement " and "of divider means" recited in claims 1 and 2, in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by any one of Cozette (Publication Number 447,701) or IAV (Publication Number DE 20,113,784) or Anderson (Patent Number 2,366,765) or Carson (Patent Number 2,581,172).

Regarding claims 1, 2 and 4, Cozette (as shown in Fig. 1) or IAV (as shown in Fig. 1); in Anderson (as shown in Fig. 2) or Carson (as shown in Fig. 5) discloses a hydraulic motor having a non-rotating annular outer casing (not numbered; however, clearly seen in Fig. 1 in Cozette; 1 in IAV; 9 in Anderson; 16 in Carson), moving eccentric means (2 in Cozette; 2 in IAV; 23, 24, 48, 79, 81 in Anderson; 46, 50, 51, 52 in Carson) inside the outer casing, a power shaft (6 in Cozette; not numbered; however, clearly seen in Fig. 1 in IAV; 8 in Anderson; 30, 31 in Carson) connected to the eccentric means and rotatable thereby, a pressure chamber arrangement communicating with the eccentric means for moving the eccentric means, and a non-rotating annular inner casing (not numbered; however, clearly seen in Fig. 1 in Cozette and Fig. 1 in IAV; 67 in Anderson; 32 in Carson) inside the non-rotating annular outer casing, wherein the eccentric means comprise an eccentric part formed in the power shafts, a first eccentric ring (2 in Cozette; 2 in IAV; 23, 24 48 in Anderson; 50, 51, 52 in Carson) between the outer casing and the inner casing, and a second eccentric ring (not numbered; however, clearly seen in Fig. 1 in Cozette and Fig. 1 in IAV; 79, 81 in Anderson; 46 in Carson) mounted with

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eccentric part of the power shaft and connected fixedly and concentrically to the first eccentric ring, whereby the pressure chamber arrangement is located between the first eccentric ring and the inner casing, and the first and second eccentric rings form a substantially non-rotating entity that only performs an eccentric movement and makes the power shaft rotate by the eccentric movement; the pressure chamber arrangement being divided into at least two equal-sized parts by divider means (not numbered; however, clearly seen in Fig. 1 in Cozette; 5 in IAV; 73-76 in Anderson; 39 in Carson) arranged through the inner casing and arranged to be in close contact with the inner surface of the first eccentric ring and the outer surface of the second eccentric ring and to move radially in relation to the inner casing guided by the eccentric rings; intake and outlet channels (not numbered; however, clearly seen in Fig. 1 in Cozette ) being arranged to the inner casing for leading hydraulic fluid, steam or pressurized air to the pressure chamber arrangement and away from it.

#### ***Allowable Subject Matter***

Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Prior Art***

The IDS (PTO-1449) filed on April 20, 2005 has been considered. An initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of two patents: Hunter (U.S. Patent Number 3,951,112) and Lohn (U.S. Patent Number 4,177,024), each further discloses a state of the art.

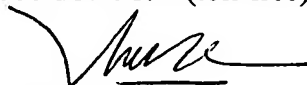
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT  
January 26, 2006

  
Theresa Trieu  
Primary Examiner  
Art Unit 3748